REMARKS

This paper is presented in response to the office action dated 10-30-2007.

ADDED CLAIMS

By this amendment, we have added claims to introduce alternative statements of the invention. These claims are amply supported throughout the text and drawings as originally filed. Accordingly, the amendments do not introduce any new matter.

REQUEST FOR LEAVE TO ADD CLAIMS IN FUTURE

It is important for Applicant to have claims of varying scope, and further important to have counterpart claims drawn to different statutory classes and claim formats. Nevertheless, we are mindful of the Examiner's burden in examining a plurality of claims. In view of this, we have configured the application to include various representative claims, while voluntarily limiting the addition of counterparts (such as apparatus, means plus function, computer-readable medium, etc). We request generous leave to introduce new counterpart claims upon an indication of allowable subject matter, by Rule 312 amendment or other appropriate means.

RESOLVING SOME CONFUSION IN OFFICE ACTION

Page 2 of the office action states that claims 21 and 22, previously rejected under 35 USC 101, have been withdrawn. To the contrary, these claims have not been withdrawn. We kindly request clarification.

SUMMARY OF MAIN ARGUMENTS

Here is a summary of some of the main arguments below.

- The Examiner's reasons for combining Maltby and Agrawal are not persuasive. The proposed combination arises only through improper hindsight reasoning.

- Agrawal should not be considered because it is nonanalogous art.

- The office action lacks other required components of the prima facie obviousness case, such as the reasonable expectation of success. As such, the prima facie obviousness case is defective.

- Even if Maltby and Agrawal are combined as the Examiner proposed, the combination still does not teach the claims. The claims include recitations of specific operations involving use of an instant messaging window as a user interface to copy contents and format of an operating clipboard from one computer to another. As to the claimed user interface features, Maltby's disclosure ranges from vague to silent. Agrawal does not fill in the blanks.

- New claims have been added to provide alternate statements of the invention. The new claims are patently distinguished over Maltby-Agrawal.

CLAIM REJECTIONS - 35 USC 102

Claims 20 was rejected under 35 USC 102 as being anticipated by US 6,202,100 B1 ("Maltby"). The examiner bears the burden of establishing a *prima facie* case of anticipation.[1] The prior art reference must disclose <u>each</u> element of the claimed invention, as correctly interpreted, and as arranged in the claim.[2] A claim is anticipated only if <u>each and every</u> element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the claim.[3]

Against this backdrop, claim 20 is patentable because the applied art does not teach the following combination:

" A process of communications between first and second computers having an open text messaging link, the computers running respective text messaging application programs providing a text messaging window at each computer for displaying an exchange of text messages, the process comprising operations of:

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1   In re King, 801 F.2d 1324, 1327, 231 USPQ 136, 138-139 (Fed. Cir. 1986).
2   Lindermann Maschinefabrik Gmbh v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984).
3   MPEP 2131.

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replicating contents and format of a first computer's operating system

clipboard in an operating system clipboard of a second computer,

where the replicating operation is conducted responsive to

coordinated user instructions submitted via respective text

messaging application programs of the first and second

computers."

Considering some specific aspects of claim 20, Maltby lacks a process of communications between first and second computers having an open text messaging link, the computers running respective text messaging application programs providing a text messaging window at each computer for displaying an exchange of text messages, as required by claim 20. Indeed, the record is clear that Maltby does not teach an instant messaging program running in an IM window. [Office Action: page 5]

To further emphasize the point, Maltby is said to show "conferencing software," but is vague as to what this means. In one passage, Maltby suggests that conferencing applications are "responsible for exchanging messages between the first and second computer." [Maltby: col. 6, lines 33-45] However, the stated exchange of messages between computers could be interpreted to mean virtually any type of communications between computers, e.g., IP packets, communications handshaking, video conferencing signals, etc. Consequently, this does not provide an enabling disclosure as to the claimed IM window (for displaying an exchange of text messages).

In another passage, Maltby suggests that an example of commercially available suitable conferencing software is Person to Person for Windows from IBM Corporation, which supports conferences between two or more people over a variety of communications links (e.g. LAN, ISDN, asynchronous). [Maltby: col. 7, lines 15-30] However, Maltby does not describe the structure or operation of the IBM product, which would likely be proprietary to IBM. Therefore, the meaning of Maltby's "conferencing software" is left to the user's imagination.

At any rate, Maltby does not describe the use of text messaging. And,

quite plainly, Maltby does not take the further step of suggesting that the completion of clipboard transfer is related to the use of IM windows.

Maltby further fails to disclose "replicating contents and format of a first computer's operating system clipboard in an operating system clipboard of a second computer, where the replicating operation is conducted responsive to coordinated user instructions submitted via respective text messaging application programs of the first and second computers."

Maltby is said to show a method where an object generated by a first application at a first computer in the network may be incorporated into a second application at a second computer in the network, via an operating system clipboard. [Maltby: col. 4, lines 33-40] However, Maltby's focus is on the protocol and other such mechanics of clipboard transfer. In this regard, Maltby focuses on technologies employing object linking and embedding (OLE) and dynamic data exchange (DDE). [Maltby: col. 4, line 33 - col. 6, line 45]

Maltby, however, fails to make substantive disclosure concerning the user interface for replicating the format and contents of an operating system clipboard. As to this aspect, Maltby is completely silent, or vague at best. Here are some examples:

- According to Maltby, because the CLIP SEND routine is a viewer of CLIPBOARD A, it is notified of any updates to CLIPBOARD A. When it is alerted to a change to CLIPBOARD A, it requests the list of available formats which it sends to CLIP RECEIVE. CLIP RECEIVE now takes ownership of CLIPBOARD B and inserts the list of formats using delayed rendering (i.e. it passes a null pointer to the operating system). [Maltby: col. 7, lines 30-50] According to this description, the clipboard send operation whenever there is a change to the clipboard, which teaches away from initiating clipboard transfer using an open IM window.
- According to another passage of Maltby, APPN A inserts data onto CLIPBOARD A using SetClipboardData (step 320). This causes a notification WM_DRAWCLIPBOARD to be sent to CLIP SEND (step 330). CLIP SEND interrogates CLIPBOARD A using EnumClipboardFormats

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(step 340) to obtain the list of formats in which the data on the clipboard is available. [Maltby: col. 7, lines 50-67; Fig. 3] According to this description, activity is triggered by APPN A inserting data onto CLIPBOARD A. However, there is no discussion of the means by which this is activated, relative to the user.

- According to Maltby, the user initially selects the clipboard entry corresponding to Object Embedding, either implicitly or explicitly, resulting in a GetClipboardData call from APPN B to CLIPBOARD B (step 410). [Maltby: col. 8, lines 8-30] However, Maltby does not explain how the user selects the clipboard entry. Further, the GetClipboardData call apparently occurs automatically from the user selection of the clipboard entry, negating the involvement of any user interface for this purpose.

Maltby, then, does not contain any meaningful disclosure of the user interface for effecting clipboard transfer, and particularly, that the claimed replicating operation is conducted responsive to coordinated user instructions submitted via respective text messaging application programs of the first and second computers, as required by claim 20.

For these reasons, Maltby fails to teach the features of claim 20.

CLAIM REJECTIONS - 35 USC 103

Claims 11-19 and 21-27 were rejected under 35 USC 103 as being obvious over Maltby as combined with US 2003/0120680 ("Agrawal"). We hereby traverse this rejection. The claims are patentable since a *prima facie* case of obviousness has not been established, as discussed in greater detail below.[4]

Teaching/Suggestion of Claim Limitations

Introduction

Even if the references were to be combined as suggested (albeit improperly, as discussed below), the *prima facie* obviousness case is incomplete

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4   MPEP 2142.

because the combination still does not teach or suggest all the claim limitations.[5] To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.[6] All words in a claim must be considered in judging the patentability of that claim against the prior art.[7]

Maltby & Agrawal, Generally

Maltby was discussed above. As for Agrawal, the office action introduced this reference merely to teach an instant messaging application and a hyperlink. [Office Action: page 30]

Agrawal's disclosure is aimed at publishing content on a computer network (like the "web"). [Agrawal: para. 0003, 0011] As part of Agrawal solution, Agrawal assigns a URL to the publisher's computer, which operates as a server to directly provide content and services. [Agrawal: para. 0012] Agrawal uses location-independent names that allow content requesters to be directed to desired content, resolving the dynamically assigned IP address problem. [Agrawal: para. 0011]

Agrawal discusses a specific process for a user to publish a file on a computer network. [Agrawal: para. 0030] The end result is that the user receives a URL pointing to the shared file. [Agrawal: para. 0030] Later, the user can self-publish the file by sharing the URL with others. In passing, Agrawal makes brief mention of a "clipboard" and "instant messaging," both incidental to Agrawal's self-publishing theme. Relatedly, Agrawal states that the URL can be copied to the clipboard, and subsequently shared with others by e-mail or instant messaging. [Agrawal: para. 0030]

Agrawal discusses one shortcut for the publishing user to copy the URL to the clipboard. Namely, a dialogue box with the resultant URL appears above a

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5   MPEP 2142, 2143.03.
6   Ex Parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). MPEP 706.02(j).
7.   In re Wilson, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970). MPEP 2143.03.

"copy to clipboard" button. Agrawal fails to discuss the "copy to clipboard" button any further. Presumably, this copies the URL into the publishing user's clipboard, offering a minor convenience by avoiding user operations that would otherwise be required to enter the exhibited URL into the user's clipboard.

Ultimately, however, Agrawal's user manually shares the URL with others, such as by "e-mail or instant messaging." Relatedly, Agrawal does not contemplate anything other than use of standard e-mail or instant messaging. Agrawal does not propose any special techniques for using or modifying e-mail or instant messaging software, or even suggest that such modification take place.

Claim 11 - Maltby

Maltby is said to show a method where an object generated by a first application at a first computer in the network may be incorporated into a second application at a second computer in the network, via an operating system clipboard. [Maltby: col. 4, lines 33-40] However, Maltby's focus is on the protocol and other such mechanics of clipboard transfer. In this regard, Maltby focuses on technologies employing object linking and embedding (OLE) and dynamic data exchange (DDE). [Maltby: col. 4, line 33 - col. 6, line 45] · Maltby, however, lacks any concern with the user interface for replicating the format and contents of an operating system clipboard. As to this aspect, Maltby is completely silent, or vague at best. We provided various examples and specific citations on this point in the discussion of Claim 20, above. Maltby, then, does not provide any meaningful disclosure of the user interface for effecting clipboard transfer.

Claim 11 - Maltby & IM program

The office action admits that "Maltby does not explicitly teach that the messaging application program is an Instant Messaging (IM) application program running an IM window." [Office Action: page 5] The office action does not go far enough, in this regard. Not only does Maltby fail to explicitly teach this feature,

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but Maltby further fails to teach it implicitly, inherently, or otherwise.

In contrast to Maltby, claim 11 recites specific details concerning the user interface for effecting clipboard transfer, and particularly, the use of IM windows (of IM application programs running on first and second computers) to replicate content and format of the first computer's operating system clipboard in the operating system clipboard of the second computer. As to the user interface for clipboard transfer, Maltby's disclosure is lacking as discussed above. And, as to the claimed use of IM windows in conjunction with clipboard replication among computers, Maltby is further lacking.

Maltby is said to show "conferencing software," but is vague as to what this means. In one passage, Maltby suggests that conferencing applications are "responsible for exchanging messages between the first and second computer." [Maltby: col. 6, lines 33-45] However, the stated exchange of messages between computers could be interpreted to mean virtually any type of communications between computers, e.g., IP packets, communications handshaking, video conferencing signals, etc. Consequently, this does not provide an enabling disclosure as to the claimed IM window (for displaying an exchange of text messages).

In another passage, Maltby suggests that an example of commercially available suitable conferencing software is Person to Person for Windows from IBM Corporation, which supports conferences between two or more people over a variety of communications links (e.g. LAN, ISDN, asynchronous). [Maltby: col. 7, lines 15-30] However, Maltby does not describe the structure or operation of the IBM product, which would be presumably proprietary to IBM, and unavailable to provide any enabling disclosure on point. Therefore, the meaning of Maltby's "conferencing software" is left to the user's imagination.

At any rate, Maltby does not describe the use of text messaging. And, quite plainly, Maltby does not take the further step of suggesting that the completion of clipboard transfer is related to the use of IM windows. In no case does Maltby teach that IM windows of IM application programs are used in replicating a clipboard from one computer to another.

For the foregoing reasons, Maltby's disclosure is particularly barren as to any operations of claim 11 requiring an IM program or IM windows, such as:

- The IM application programs cooperatively replicating contents and format of a clipboard provided by an operating system running at the first computer in a clipboard provided by an operating system running at the second computer.

- The first computer receiving a predetermined user input sequence including invocation of a predetermined clipboard paste command of the operating system running at the first computer, where the predetermined user input sequence is performed in conjunction with the IM window at the first computer.

- The IM application program running on the second computer presenting a user prompt in conjunction with the IM window of the second computer, the user prompt including notification that clipboard contents and format from the first computer are available to the second computer."

- The IM application program running on the second computer detecting user selection of the user prompt.

In view of the foregoing, Maltby does not teach the features of claim 11.

Claim 11 - Detailed Analysis

Considering claim 11 in greater detail, the proposed Maltby-Agrawal combination lacks a number of claimed features.

The references do not teach "**the first computer receiving a predetermined user input sequence including invocation of a predetermined clipboard paste command of the operating system running at the first computer, where the predetermined user input sequence is performed in conjunction with the IM window at the first computer.**"

The office action equates the claimed paste command with Maltby's col. 1, lines 51-58 ("The user (generally with a mouse and cursor) would first identify the text to be copied from the first (server) application, and then select the appropriate menu option to place this text in the clipboard.")

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This argument is unpersuasive for two reasons. First, the operation of placing text in the clipboard is clearly a "copy" operation ("...select the appropriate menu operation to place this text in the clipboard...") and not a "paste" operation. Therefore, the cited passage is inapplicable. Furthermore, this passage occurs in Maltby's discussion of prior art, and there is no evidence that this technology is incorporated or even related into the disclosure of Maltby's invention in any way. Indeed, Maltby specifically teaches away from this prior art approach by describing it as awkward and tedious. [Maltby: col. 2, lines 15-30]

Maltby also fails to teach "**the IM application program running on the second computer presenting a user prompt in conjunction with the IM window of the second computer, the user prompt including notification that clipboard contents and format from the first computer are available to the second computer.**"

The office action argues that this feature is found in Maltby's col. 3, lines 38-43 ("possible by double clicking on the object as seen from the target application to launch the server application and use it to process the object") and col. 3, lines (28-35) ("contains extra information over and above the bit map, text, or whatever representing the appearance of the object: it also contains the name (at least) of the original source application, plus (for Object Embedding) a native format including all the original control information held by the server application about that object").

This argument is unpersuasive for several reasons. First, the argument that a possibility of "double clicking on the object" constitutes a "user prompt" does not really make any sense. Second, by Maltby's own words, the citation as to "lines contains extra information over and above the bit map" does not seem to have any relation to a user prompt. Therefore, it is not clear what the Examiner is arguing.

Second, the cited passages occur in Maltby's discussion of prior art. As to this prior art, Maltby specifically notes that, "it has not provided a comprehensive solution that is both flexible and relevant to existing applications." [Maltby: col. 29-33] Therefore, the citation of Maltby's background section is deemed

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inapplicable in the absence of a persuasive argument for combining the disclosure of Maltby's invention with the prior art solutions that are neither comprehensive, flexible, nor relevant.

This situation is further illustrated using a hypothetical example. In a patent, the patentee describes his invention, a turbojet engine. As background to his patent, the patentee describes various early aircraft power schemes including the first ornithopter (a machine that flies by flapping wings), constructed by Gustave Trouvé in 1870. Using the logic of the present office action, it would be proper to construct a rejection applying the features of the patentee's jet engine and features of Trouvé's ornithopter simply because their description occurred in the same document, even though nobody has ever conceived or taught an invention combining such features.

Maltby also lacks the claimed feature **"the IM application program running on the second computer detecting user selection of the user prompt."** The office action cited Maltby's col. 7, lines 64-67 ("and become available for user selection") in regard to the claimed feature. Not only does the cited feature fail to teach the claimed limitation, but it actually teaches away from it. Considering this citation in context, a list is passed to remote terminal B using standard messaging software. CLIP RECEIVE uses the call SetClipboardOwner to become the owner of CLIPBOARD B (step 360). The formats are then inserted onto CLIPBOARD B (step 370) using the delayed rendering option in SetClipboardData, and become available for user selection. [Maltby: col. 7, lines 50-67] According to this sequence, the formats inserted into CLIPBOARD B automatically become available for user selection, as there is absolutely no mention of a user prompt. At best, Maltby's disclosure fails to provide an enabling disclosure as to the claimed feature. Consequently, the claimed feature is patentably distinguished from Maltby.

Claim 11 - Agrawal

Considering Agrawal in the context of claim 11, Agrawal falls short of the claimed operation "the IM application programs cooperatively replicating contents

and format of a clipboard provided by an operating system running at the first computer in a clipboard provided by an operating system running at the second computer."

For one, there is no discussion of replicating the sender's clipboard in the recipient's clipboard. At best, Agrawal might provide a text message (the URL) in the recipient's e-mail message or instant message, but there is no suggestion of replicating this in the recipient's clipboard. Agrawal's only discussion of the technique for sharing the URL with others is merely: "e-mail or instant messaging." [Agrawal: para. 0030] Although Agrawal is silent on the matter, Applicant speculates that Agrawal's user might manually cut and paste the URL into an e-mail or instant message. At any rate, Agrawal does not show "the IM application programs... replicating contents and format... in a clipboard provided by an operating system running at the second computer."

Furthermore, as Agrawal does not elaborate on what it means to "share the URL with others via e-mail or instant messaging," Agrawal does not show the IM application programs replicating "format of a clipboard..." as claimed. One speculated meaning, simply cutting and pasting text into an instant messaging window, certainly falls short of replicating contents and format of a clipboard.

Furthermore, Agrawal does not show "the IM application program running on the second computer presenting a user prompt in conjunction with the IM window of the second computer, the user prompt including notification that clipboard contents and format from the first computer are available to the second computer" as claimed. Although Agrawal does provide any related explanation, Applicant speculates that to "share the URL with others via... instant messaging" would merely involve presenting clipboard text on the recipient's instant message screen. Hence, the required user prompt is lacking.

Claims 12-15

These claims are patentable for similar reasons as claim 11, discussed above. The claims are also patentable for additional reasons. Taking claim 12 as an example, this claim performs a number of operations in response to user

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activity, such as "responsive to the first computer receiving a predetermined user input sequence including invocation of a predetermined paste command..." and "responsive to the IM application program running on the first computer receiving user entry of a send command..." and "the IM application program running on the second computer presenting a user prompt in conjunction with the IM window of the second computer" and "the IM application program running on the second computer, responsive to user selection of the user prompt..."

Maltby does not substantively address addresses the user interface features of Maltby's system. The office action states that Maltby does not stress the "user interface" aspect of the invention. [Office Acton: page 30] This understates the situation. Maltby is wholly defective as to any meaningful disclosure concerning the user interface aspect of the exchange of clipboard contents, and moreover, by Maltby's disclosure much of Maltby's system operates autonomously without regard for user input.

And, although the office action applied various passages of Maltby to the claimed language (pages 6-8), all of these passages are silent as to the claimed user interface features. In contrast to the office action's proposal, the clear language of Maltby shows that Maltby operates largely autonomously with respect to the user. After the user selects a clipboard entry in the following passage, for example, there is no disclosed activity involving the user at all.

The processing involved with satisfying the OLE request is illustrated in FIG. 4. Initially the user selects the clipboard entry corresponding to Object Embedding, either implicitly or explicitly, resulting in a GetClipboardData call from APPN B to CLIPBOARD B (step 410). Since all the formats are inserted onto CLIPBOARD B using delayed rendering (to save the bandwidth of transmitting formats which are never required) the operating system passes the clipboard request back to CLIP RECEIVE, the origin of the clipboard entry, using WM_RENDERFORMAT (step 420). This request is converted into a message sent from CLIP RECEIVE to CLIP SEND (step 430). CLIP SEND now interrogates the corresponding entry on CLIPBOARD A, using GetClipboardData (step

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440) which will produce the data string corresponding to "Application.Topic.Item.." (this may be directly available from the clipboard, or provided by APPN A using delayed rendering: step 450). CLIP SEND then sends a message containing this data string across to CLIP RECEIVE (step 460). Once it has received the requested data, CLIP RECEIVE passes the data to CLIPBOARD B (step 470), thereby satisfying the delayed rendering request, and CLIPBOARD B forwards the data to APPN B (step 480).   [Maltby: col. 8, lines 8-30]

Claim 12 contains a number of features operating in response to user activity, or presenting data to the user, all of these missing from Maltby. On this same theme, claims 13-16 recite further user interface features that are similarly missing from Maltby.

Claims 16-19

These claims contain details that, further to the reasoning above, further define the claims over the applied art. However, there is no need to address the individual merits of these dependent claims. They are patentable simply because they depend from independent claim 11, which is allowable as discussed above.

Nevertheless, some observations are made as to claim 17. The office action suggests that Agrawal teaches that the user prompt comprises a hyperlink. [Office Action: page 28] Upon a more careful reading of Agrawal's disclosure against the claims, Agrawal teaches no such feature. Claim 17 recites "the user prompt comprising a hyperlink," which refers to claim 11's statement that "the IM application program running on the second computer presenting a user prompt in conjunction with the IM window of the second computer, the user prompt including notification that clipboard contents and format from the first computer are available to the second computer."

There is nothing in Agrawal to teach that the IM application program running on the second computer presents a hyperlink including notification that

the clipboard is available to the second computer. Rather, Agrawal concerns a "one-click" process enabling a user to publish a file on a computer network. [Agrawal: para. 0030] When that user publishes a file, his own computer presents a confirmation dialog (Fig. 2), indicating the URL of the published file and providing a button to copy the URL into the user's clipboard. [Agrawal: para. 0030] Agrawal, however, says nothing about providing a prompt to a user on the other end. Indeed, Agrawal is silent as to the actions at the receiving computer. Moreover, Agrawal does not contemplate that such a prompt (that clipboard contents and format from the first computer are available to the second computer) may be in the form of a hyperlink. For these reasons, claim 17 is patentable *a fortiori* over Maltby-Agrawal.

Claim 21

This claim is patentable for the same reasons as claim 11. This claim is a 'computer storage medium' counterpart to claim 11.

Claim 22

This claim is patentable for the same reasons as claim 20. This claim is a 'computer storage medium' counterpart to claim 20.

Claims 23-24

These added, dependent claims contain details that, further to the reasoning above, further define the claims from the applied art. However, there is no need to address the individual merits of these dependent claims. They are patentable simply because they depend from independent claim 11, which is allowable as discussed above.

Claims 25-31

These claims are patentable for reasons analogous to those discussed above, and beyond this, for further reasons arising from their specific language that contrasts with claim 11.

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Reason to Combine

Introduction

In addition to the reasons given above, the *prima facie* obviousness case is also defective because there has been no adequate showing of a reason that would have prompted an ordinarily skilled artisan to combine the elements in the way the claimed invention does.[8] **The Supreme Court in KSR v. Teleflex has recognized that a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.**[9]

In its combination of Maltby and Agrawal, the office action engages in this demonstration precisely. Namely, the office action eviscerated the claims by removing every instance of "instant messaging" and then applying Maltby to the remainder. To wit, the office action has gone beyond "elements," and sought to dissect sentences, alleging that different words are found in different references.

Clearly, if this practice were permitted, than nothing would be patentable. Cold fusion might be rendered obvious because processes for achieving cold (refrigeration) are known in the art, and fusion is also known. Dissecting claims language down to this level reduces the claims to a nondescript pulp, wholly abrogating the intended meaning of original language. This fails to consider the claimed invention as a whole.

For instance, by removing "IM" from the claim feature "where the predetermined user input sequence is performed in conjunction with the IM window at the first computer," this removes the essence of the claims. Likewise, "the IM application programs cooperatively replicating contents and format of a clipboard" is aimed at a novel use of IM application programs, and by removing such language in order to dissect the claim, this effectively destroys the claim.

However, hindsight reconstruction, using the applicant's specification itself as a guide, is improper because it fails to consider the subject matter of the

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8   KSR Int'l Co. v. Teleflex, 127 S.Ct. 1727, 1741 (2007).
9   Id.

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invention "as a whole" and fails to consider the invention as of the date at which the invention was made.

The Supreme Court also recognized that "helpful insight" on this point is available by considering whether there is any suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.[10] Furthermore, the Patent Office has acknowledged that, in formulating a rejection under section 103 based upon a combination of prior art elements, it remains <u>necessary</u> to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.[11]

Analysis - Reason to Combine

The office action proposed adding Agrawal's Instant Messaging (IM) feature to Maltby "so that messaging [*sic*] application is an Instant Messaging (IM) application program running an IM window." [Office Action: pages 5-6] The alleged motivation would be that "Maltby teaches that the applications running on terminal A and terminal B are conference software which are essentially enhancements to the known prior art data communications software. [Office Action: page 6]

However, Maltby already suggests a purportedly adequate conference software, namely, "Person to Person for Windows software" from IBM Corporation. This software is produced by Maltby's presumed employer, the assignee of Maltby's patent application. This software is already said to "support conferences between two or more people over a variety of communications links (e.g. LAN, ISDN, asynchronous). are." [Office Action: page 6] Hence, there is nothing to suggest any problem or need to expand or change Maltby's disclosure as-is. There is nothing in the suggested disclosure of Agrawal that Maltby does not already have.

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10   Id.
11   USPTO memo from Margaret A. Focarino, Deputy Commissioner for Patent Operations, dated May 3, 2007.

Indeed, if Agrawal's IM application program were substituted for Maltby's conferencing software, Maltby's system would suffer. According to Maltby's own words, Maltby's conferencing software is already said to exchange messages between the first and second computers, interact via the clipboard with the first and second applications at their respective computers, implement the OLE between the two terminals, interact with COMMS software to exchange messages between terminals A and B using conventional communication protocols, etc. In view of this, why modify Maltby to use Agrawal's simply IM program instead of Maltby's more capable conference software?

The introduction of Agrawal is also improper because it ignores **problem recognition** as an element of the obviousness inquiry.[12] The office action proposes that an ordinarily skilled artisan would be motivated to add the teachings of Agrawal to Maltby because Maltby teaches that his applications are "conferencing software which are essentially enhancements to the known prior art data communications." [Office Action: page 6] There is nothing to suggest that Maltby's system had any faults. Furthermore, a general incentive does not make a particular result obvious, nor does the existence of techniques by which those efforts can be carried out.[13]

Moreover, in the absence of hindsight reconstruction, the rationale for combining Maltby and Agrawal does not make sense. There has been no reasoning, in easy-to-understand terms, of any a real benefit.

Further, the proposed benefit itself ("applications running on terminal A and terminal B are conferencing software which are essentially enhancements to the known prior art data communications software") does not seem like any benefit at all. Rather, the office action has cherry-picked features from Agrawal for addition to Maltby, in order to compensate for perceived shortcoming in Maltby's disclosure. With nothing more, the Maltby-Agrawal combination is merely the result of hindsight reconstruction.

However, it is improper to attempt to establish obviousness by using the

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12   Gillette Co. v. S.C. Johnson & Son, 919 F.2d 720, 16 USPQ2d 1923 (Fed. Cir. 1990); In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).
13   In re Deuel, 51 F.2d 1552, 34 USPQ2d 1210 (Fed. Cir. 1995).

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applicant's specification as a guide to combining different prior art references to achieve the results of the claimed invention.[14] The teaching or suggestion to make the claimed combination must be found in the prior art, and not based on applicant's disclosure.[15] The critical inquiry is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.[16] Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art."[17] But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination."[18] And "teachings of references can be combined only if there is some suggestion of incentive to do so."[19]

"To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher."[20] It is essential that "the decisionmaker forget what he or she has been taught at trial about the claimed invention and cast the mind back to the time the invention was made. . . to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the

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14   Orthopedic Equipment Co., Inc. v. United States, 702 F.2d 1005, 1012, 217 USPQ 193, 199 (Fed. Cir. 1983).
15   In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).
16   In re Fritch, 23 USPQ 2d 1780, 1784 (Fed. Cir. 1992) ("It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious."); Fromson v. Advance Offset Plate, Inc., 755 F.2d 1549, 1556, 225 USPQ 26, 31 (Fed. Cir. 1985) (nothing of record plainly indicated that it would have been obvious to combine previously separate lithography steps into one process). See e.g., In re Gordon et al., 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (mere fact that prior art could be modified by turning apparatus upside down does not make modification obvious unless prior art suggests desirability of modification); Ex Parte Kaiser, 194 USPQ 47, 48 (Pat. Bd. of App. 1975) (Examiner's failure to indicate anywhere in the record his reason for finding alteration of reference to be obvious militates against rejection).
17   In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).
18   ACS Hosp. Sys. Inc. v. Montefiore Hosp., 32 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).
19   Id.
20   W. L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

art."[21]

The policy of the Patent and Trademark Office[22] is to follow in each and every case the standard of patentability enunciated by the Supreme Court in *Graham v. John Deere Co.*[23] As stated by the Supreme Court:

> Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or non-obviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy.[24]

Thus, hindsight reconstruction, using the applicant's specification itself as a guide, is improper because it fails to consider the subject matter of the invention "as a whole" and fails to consider the invention as of the date at which the invention was made.

As a further reason against making the Maltby-Agrawal combination, it would be improper to add Agrawal because Agrawal constitutes **non-analogous art** to the claimed invention.

For the teachings of a reference to be prior art under 35 USC 103, there must be some basis for concluding that the reference would have been considered by one skilled in the particular art working on the particular problem with which the invention pertains.[25] Non-analogous art cannot properly be pertinent prior art under 35 USC 103.[26] The determination of whether a reference is from a non-analogous art is set forth in a two-step test provided by *Union Carbide Corp. v. American Can Co.*[27] In *Union Carbide*, the court found that the first determination was whether "the reference is within the field of the

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21   Id.
22   MPEP 2141.
23   148 USPQ 459 (1966).
24   148 USPQ at 467.
25   In re Horne, 203 USPQ 969, 971 (CCPA 1979).
26   In re Pagliaro, 210 USPQ 888, 892 (CCPA 1981).
27   724 F.2d 1567, 220 USPQ 584 (Fed. Cir. 1984)

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inventor's endeavor." If it is not, one must proceed to the second step "to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved." In regard to the second step, "analogous art is that field of art which a person of ordinary skill in the art would have been apt to refer in attempting to solve the problem solved by a proposed invention."[28] "To be relevant the area of art should be where one of ordinary skill in the art would be aware that similar problems exist."[29]

Agrawal is **outside the field of the inventors' endeavor**. Agrawal concerns a the providing of content and services to users of a computer network such as the Internet directly from a provider's computer using existing file transfer protocols. [Agrawal: para. 0002] In contrast, the inventors' endeavor concerns transferring a fragment of a document via an Internet based messaging system, with the transferred data being available on a receiving computer's clipboard, when pasted into another document in the receiving computer. [Specification: page 1, lines 5-10]

Nor is Agrawal concerned with the **particular problem confronting the present inventors**. Specifically, the inventors were concerned with the following problem. "In fact, although all existing messaging systems, such as MSN, Yahoo Messenger, AIM, and NetMeeting, allow users to exchange textual data directly through the communication screen and allow users to send a document or a photo to a receiving user's e-mail address, they do not facilitate transfer of entire data from a sending user's clipboard to a receiving user's clipboard, and thus a sending user cannot use any of the current messaging systems to send a fragment of document to a receiving user's clipboard so that the receiving user pastes the clipboard content into a document in the receiving computer." [Specification: page 7, line 18 - page 8, line 4] In contrast, Agrawal is concerned with the problem that publishing content on a computer network like the web is expensive and difficult. [Agrawal: para. 0003]

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28   Bott v. Fourstar Corp., 218 USPQ 358 (E.D. Mich. 1983).
29   Id.

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As further evidence of nonanalogy, the subject invention and Agrawal are classified differently. The present invention is preliminary classified in class 709 (Electrical Computers and Digital Data Processing Systems: Multicomputer Data Transferring), subclass 207 (Priority Based Messaging). Subclass 207 concerns means or steps for organizing and inter-relating data or files, including relational, network, hierarchical, and entity-relationship models, among others. In contrast, Agrawal is classified in class 707 (Data Processing: Database and File Management or Data Structures), subclass 103R. Subclass 103R is defined as subject mater further comprising an object-oriented data structure and its maintenance in memory, which is indented under subclass 100 (Database Schema or Database Structure). Accordingly, this is further evidence of nonanalogy. MPEP 2141.01(a)

Resolving Level of Ordinary Skill

The office action's case is also incomplete because it does not resolve the level of ordinary skill in the pertinent art as specifically required by the Supreme Court in KSR v. Teleflex.[30] "Any obviousness rejection should include... an indication of the level of ordinary skill.[31]

The Supreme Court has further that "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."[32] The Court required that analysis supporting a section 103 rejection should be made explicit.[33] Moreover, the Court confirmed that this analysis is equally applicable to the courts and patent examiners.[34]

Conclusion - Reason to Combine

In conclusion, the *prima facie* obviousness case is incomplete because

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30   KSR Int'l Co. v. Teleflex, 127 S.Ct. 1727, 1734 (2007).
31   Examination Guidelines for Determining Obviousness Under 35 USC 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc., Federal Register Vol. 72, No. 195, Page 57528
32   Id. at 1741.
33   Id.
34   Id. at 1734.

the office action does not provide a sufficient reason as to why one of ordinary skill would have made the proposed combination of references.

Reasonable Expectation of Success

In addition to the reasons stated above, the *prima facie* obviousness case is further defective because the office action failed to show that there would be a reasonable expectation of success in modifying/combining references.[35] The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.[36] If the examiner does not produce a prima facie case, the applicant is under *no* obligation to submit evidence of nonobviousness.[37] Critically, to establish a *prima facie* case of obviousness, there must be a reasonable expectation of success.[38] This reasonable expectation of success must be found in the prior art, not in Applicant's disclosure.[39] The office action lacks any evidence, allegation, or other mention of the legally required "reasonable expectation of success." Since this mandatory topic is unaddressed by the office action, no *prima facie* case of obviousness has been properly established.

Conclusion as to Claims 11-19, 21-27

As shown above, then, these claims are patentable since a *prima facie* case of obviousness does not exist. Namely, (1) the applied art fails to teach the features of the claims, (2) there is insufficient motivation to combine/modify references as proposed by the office action, and (3) there is no showing that an ordinarily skilled artisan would have a reasonable expectation of success in making the office action's proposed modification of references.

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35   MPEP 2142, 2143.02.
36   MPEP 2142.
37   Id.
38   MPEP 2143.
39   In re Vaeck, 947 F.2d 488, 20 USPQ.2d 1438 (Fed. Cir. 1991). MPEP 2143.

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FEES

Applicant does not believe that filing of this Amendment will incur additional fees. However, the Commissioner is authorized to charge any fees due to the Glenn Patent Group Deposit Account No. 07-1445, Customer No. 22862.

Respectfully Submitted,

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